

REMARKS

The applicants respectfully request reconsideration in view of the amendment and the following remarks. The applicants have incorporated subject matter from DIN 53461-B into the specification. The applicants have amended page 25 of the specification as suggested by the Examiner. The applicants have corrected the typographical error in claim 47. Support for amended claims 51 and 53 can be found in the specification at page 5, the second and fourth paragraphs. Support for the priority document for claims 51 and 53 can be found in the priority document at page 7, line 5.

The disclosure is objected to because of the following informalities:

(1) The specification at page 4, lines 22-23, discloses a polyolefin resin having a cyclic structure having a heat distortion temperature (HDT) as measured by the DIN 53461-B method of 70°C or higher. However, the instant specification does not define the standard DIN 53461-B, nor the experimental conditions under which the HDT is determined.

The determination of HDT is essential matter, since it is necessary to describe and enable the instant claimed subject matter. Essential subject matter must be disclosed in the specification as filed.

(2) The specification at page 25, lines 1-2, refers to Examples 20 to 30 and Comparative Examples 5 and 6. However, amended Tables 1 and 3 filed in Amendment 10/14/03 do not list said examples.

Claims 35, 36, 38, 39, 41-47, 49-52, 55, 56 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Claims 35, 36, 38, 39, 41-47, 49-52, 55, 56, and 58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 47 is objected to because of a typographical error. Claims 50-52 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 97/05529 (WO '529), as evidenced by applicants' admission at page 21 of the instant specification and the American Chemical Society (ACS) File Registry No. 3611391-57-3. Claims 35, 36, 44-47, 49, 55, and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,210,852 B1 (Nakamura '852). Claims 35, 36, 38, 39, 41, 46, 47, 49, 50, 51, 55, and 58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 and 21-27 of copending Application No. 09/000,330 (Application '330) in view of Diamond, Handbook of Imaging Materials, p. 170, and US 5,707,772 (Akimoto). The applicants respectfully traverse these rejections.

35 U.S.C. §112 REJECTION

Claims 35, 36, 38, 39, 41-47, 49-52, 55, 56 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 35, 36, 38, 39, 41-47, 49-52, 55, 56, and 58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 35, 49, and 56, and claims dependent thereon, are indefinite in the limitation "a heat distortion temperature [HDT] as measured by the DIN 53461-B method of 70 °C or higher" because it is not clear what is the scope of the limitation. The Examiner

asserted that the instant specification does not define the standard DIN 53461-B. The Examiner also asserted that the instant specification does not disclose the conditions and criteria used in the standard to determine the HDT, nor does it disclose the date or version of DIN 3461-B that was relied on in the specification.

The applicants have incorporated the experimental data section from DIN 53461. The appropriate revision of the DIN 53461 would be the one that was currently in use at the time of the filing of the application (revised January 1987). If the applicants would have wanted the earlier 1969 revision, the specification would have stated that. Enclosed is a copy of the certified translation of DIN 53461 (the original is filed in Serial Number 09/000,330). For the above reasons the applicants believe the specification is enabled and that the amendment to the specification adds no new matter. For the above reasons these rejections should be withdrawn.

OBJECTION TO CLAIM 47

Claim 47 is objected to because of a typographic error "he" should be corrected to – The-. The applicants appreciate the Examiner finding this typographical error. The applicants have corrected claim 47 and for the above reasons, this rejection should be withdrawn.

REJECTION OF CLAIMS 50-52

Claims 50-52 are rejected under 35 U.S.C. 102(a) as being anticipated by WO '529, as evidenced by applicants' admission at page 21 of the instant specification and the American Chemical Society (ACS) File Registry No. 3611391-57-3. The applicants have amended claims 50 and 52 so that claims 50-52 are supported by the priority document at page 7 of the translation. The applicants have amended the term "cyclic and/or-polycyclic" to "cycloolefin".

Therefore, these claims have support in the priority document and WO' 529 is no longer applicable prior art and this rejection should be withdrawn.

DOUBLE PATENTING REJECTIONS.

Claims 35, 36, 44-47, 49, 55, and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,210,852 B1 (Nakamura '852). Claims 35, 36, 38, 39, 41, 46, 47, 49, 50, 51, 55, and 58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 and 21-27 of copending Application No. 09/000,330 (Application '330) in view of Diamond, Handbook of Imaging Materials, p. 170, and US 5,707,772 (Akimoto). In order to expedite prosecution the applicants previously submitted a terminal disclaimer that obviates these rejections. For the above reasons, these rejections should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

A notice of Appeal was previously filed. Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05587-00343-US from which the undersigned is authorized to draw.

Respectfully submitted,

By

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